

REMARKS

Status of the Claims*Pending claims*

Claims 1, 6, 8, 24, 27, 31, 33, 34, 38 to 43, 46, 49, 51, 53, 55, 57, 58, 60, 61, 65, 66, 83, 84, 93, 94, 98, 100 to 102, 104 to 108, 110 to 114, 118, 123, 128, 130, 133, 143 to 146, 148, 152, 153, 158, 160, 164, 165, 168 to 171, 174, 175, 178, 181 to 183, 197, 200, 205, 212 and 227 to 231 as filed are pending.

Claims added and canceled in this response

Claims 1, 6, 8, 24, 27, 31, 33, 34, 39 to 43, 46, 49, 51, 53, 55, 57, 58, 101, 106, 108, 112, 118, 128, 130, 133, 143 to 146, 148, 152, 160, 164, 168, 170, 171, 174, 181 and 228 are canceled without prejudice or disclaimer; and, claims 234 to 260 are added.

Thus, after entry of this amendment, claims 38, 61, 65, 66, 83, 84, 93, 94, 98, 100, 102, 104, 105, 107, 110, 111, 113, 114, 123, 153, 158, 165, 169, 175, 178, 182, 183, 197, 200, 205, 212, 227, 229 to 231 and 234 to 260, will be pending and under consideration.

Support for the claim amendments

The specification sets forth an extensive description of the invention in the amended claims. For example, support for the amended claims can be found in the claims as filed. Support for claimed genus's of the invention encompassing polypeptides having various sequence identities to the exemplary SEQ ID NO:2 of the invention can be found, inter alia, in paragraphs [0013], [0038] and [0039] of U.S. Patent Application Publication No. 20050108789 ("the '789 publication). Support for claimed genus's of the invention encompassing synthetic polypeptides can be found, inter alia, in paragraphs [0126], [0127] and [0330] of the '789 publication. Support for claimed genus's of the invention encompassing enzymatically active fragments, or active sites, can be found, inter alia, in paragraphs [0326] and [0329] of the '789 publication. Accordingly, Applicants respectfully submit that no new matter is introduced by the instant amendment.

The Group Restriction Requirement

The Office alleged there are XXVIII separate and patentably distinct species under 35 U.S.C. §121, as set forth in pages 2 to 6, of the OA.

The Group Election

Applicants elect Group II, including claims drawn to, inter alia, polypeptides, phospholipases, protein preparations, heterodimers and homodimers, immobilized polypeptides, antibodies, hybridomas and chimeric polypeptides (see page 2, section II, of the OA), with partial traverse. After entry of the instant amendment, all of the pending claims not withdrawn will be encompassed by Group II.

Rejoining process claims under In re Ochiai

Applicants thank the Examiner for noting that after the elected product claims have been found to be allowable, all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims should be rejoined. MPEP §821.04, §821.04(a), §821.04(b); pgs 800-63 to 800-69, 8th Edition, Rev. 3, Aug. 2005; In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1995); 1184 OG 86, 3/26/96.

Applicants note that Groups encompassing withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims include claims directed to use of the elected polypeptides of the invention in Group IV, Group VIII, Group X, Group XI, Group XII, Group XIV, Group XVIII, Group XIX, Group XXI, Group XXIV, Group XXVI, Group XXVII and Group XXVIII.

The Sequence Restriction Requirement

The Office alleged Groups I to XXVIII read on patentably distinct nucleic acid and polypeptide sequences, as set forth on page 10, of the OA.

The Sequence Election

Applicants elect SEQ ID NO:2, including the genus polypeptides having a sequence identity to SEQ ID NO:2.

Reasons to reconsider and withdraw restriction requirement

Applicants respectfully request the Patent Office reconsider and, in part, withdraw the restriction requirement for the following reasons:

Applicants respectfully request the Patent Office rejoin Group VIII to the elected Group II.

Applicants respectfully aver that a complete search directed to the elected Group II, drawn to, inter alia, polypeptides, phospholipases, protein preparations, heterodimers and homodimers, immobilized polypeptides, antibodies, hybridomas and chimeric polypeptides of the invention, would necessarily encompass all of Group VIII, drawn to arrays comprising immobilized polypeptides of the invention. In other words, a complete search of the prior art for a genus of polypeptides based on SEQ ID NO:2 would necessarily also encompass a complete search of the immobilized polypeptide array art. Thus, there is no extra burden on the Examiner - Group VIII must be searched during the course of a complete and thorough search for the elected Group II polypeptide sequences of the invention.

CONCLUSION

It is believed that the all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants traversed the restriction requirement, in part, and respectfully requested the Patent Office rejoin Group VIII to the elected Group II.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 564462004220. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

If the Examiner believes a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Dated: October 12, 2006

Respectfully submitted,

By 

Gregory P. Einhorn

Registration No.: 38,440

MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858) 720-5133 direct line
general office 858 720 5100
fax direct 858 523 5933
fax office 858 720 5125
email geinhorn@mofo.com